

Notice of Allowability

Application No.

09/462,387

Examiner

Callie E. Shosho

Applicant(s)

DANIEL ET AL.

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amendment filed 11/28/03 and telephonic interview conducted 2/19/04.
2. ☒ The allowed claim(s) is/are 13 and 15-29.
3. ☐ The drawings filed on _____ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some* c) ☐ None of the:
 1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
 6. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
 - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
 - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
 - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

1. ☐ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date _____
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☒ Interview Summary (PTO-413), Paper No./Mail Date 2/19/04.
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other _____

Callie E. Shosho
Primary Examiner
Art Unit: 1714

Examiner's Amendment

1. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

(1) In the specification, page 41, delete line 13 of the Abstract, "Tire tread and tire casing comprising such a composition."

(2) In the specification, page 41, line 1 of the Abstract, after "sulfur" and before ",", insert "and tire tread and tire casing comprising the composition".

(3) In the specification, page 41, line 1 of the Abstract, after "that" and before "comprises", delete "it" and insert "the composition".

(4) Claim 16, line 2, after "2" and before ",", insert "and up to 8".

(5) Claim 16, line 3, after "2" and before "for", insert "and up to 8".

2. Authorization for this examiner's amendment was given in a telephone interview with Rochelle Seide on 2/19/04.

Statement of Reasons for Allowance

3. The present claims are allowable over the "closest" prior art Hahn (U.S. 6,517,653), Hojo (U.S. 5,939,493), and Jalics et al. (U.S. 5,708,053) for the following reasons:

(a) Hahn discloses rubber composition vulcanizable with sulfur that comprises diene polymer, silica, silica coupler identical to that of presently claimed formula (I), guanidine, and amine. It is disclosed that upon vulcanization, the rubber composition is used for many purposes including tire tread.

However, the filing date of Hahn lies between the filing date and the priority date of the present application as seen below:

Application No. 09/462,387 *priority date* – 7/9/97

Hahn *filing date* – 8/20/97

Application No. 09/462,387 *filing date* – 6/26/98

Under MPEP 706.02(b), rejections based on 35 U.S.C. 102(e) can be overcome by perfecting the filing date of the priority document. Applicant's submission of certified priority document on 1/6/00 and its English language translation on 11/28/03 results in the perfection of the foreign priority filing date. Thus, Hahn is no longer applicable against the present claims.

(b) Hojo discloses sulfur vulcanized rubber composition comprising rubber such as polybutadiene, styrene-butadiene, and polyisoprene, silica, silane coupling agent identical to that

presently claimed, and free tertiary amine such as trioctylamine. It is further disclosed the composition is suitable for use in a tire tread and sidewall composition. However, there is no disclosure of guanidine as required in all the present claims.

In order to meet the presently claimed limitation regarding guanidine, Hojo was combined with Jalics et al., which disclose rubber composition comprising guanidine. It is noted that while Jalics et al. also disclose the use of amine, it is but one of several accelerators disclosed by Jalics et al. with no disclosure or motivation to select out the amine as more favorable than the other accelerators. Further, there is no explicit disclosure that the amine is an aliphatic or cycloaliphatic amine as required in the present claims. Additionally, there is no disclosure or suggestion in Jalics et al. of at least one diene polymer that has at least one amino terminal group of an aliphatic or cycloaliphatic amine which is bonded thereto at the end of the chain.

The above is especially significant in light of both the comparative data found in the present specification as well as applicants' 1.132 declaration filed 5/27/03.

The present specification provides comparative data wherein rubber composition within the scope of the present claims (for instance, composition 4, composition 6, or composition 19), i.e. comprising aliphatic or cycloaliphatic amine, is compared with rubber composition outside the scope of the present claims (for instance, composition 1, composition 5, or composition 16), i.e. comprising no aliphatic or cycloaliphatic amine. It is shown that the rubber composition of the present invention of the present invention is superior in that it possesses lower values of $\text{tg}\delta$ and G'' , i.e. exhibits reduced hysteresis.

Art Unit: 1714

Further, applicants' 1.132 declaration filed 5/27/03 compares rubber composition within the scope of the present claims (composition 19), i.e. comprising guanidine, with rubber composition outside the scope of the present claims (composition 17'), i.e. comprising no guanidine. It is disclosed that the rubber composition of the present invention is superior in that it possesses lower values of $\text{tg}\delta$ and G'' , i.e. exhibits reduced hysteresis.

Thus, the comparative data in the present specification and the 1.132 declaration are successful in establishing unexpected or surprising results over the cited prior art.

In light of the above, it is clear that Hojo and Jalics et al., either alone or in combination, do not disclose the present invention.

Thus, it is clear that the rejections of record are untenable and so, the present claims are passed to issue.

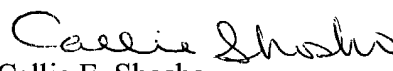
Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Art Unit: 1714

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Callie E. Shosho whose telephone number is 571-272-1123. The examiner can normally be reached on Monday-Friday (6:30-4:00) Alternate Fridays Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on 571-272-1119. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Callie E. Shosho
Primary Examiner
Art Unit 1714

CS
2/19/04